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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/755,781 | 01/05/2001 | Craig S. Skinner | PALM-3551.US.P | 3204 |

7590 01/10/2006
WAGNER, MURABITO & HAO LLP
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EXAMINER

CHEN, ALAN S

ART UNIT PAPER NUMBER

2182

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/755,781

Applicant(s)

SKINNER, CRAIG S.

Examiner

Alan S. Chen

Art Unit

2182

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-11 and 13-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-4, 6-11 and 13-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner contacted the applicant representative, Mr. John Ryan (Reg. 47,050), regarding further amending the claims to better reflect the invention, without changing the scope of the claims. Examiner and Mr. Ryan agreed on adding language to the independent claims (1, 8 and 15), particularly language where the automatic configuration of a device to communicate with the network is accomplished *without any user input*. This is consistent with Examiner's reason for allowance submitted 06/21/2005 and the applicant's arguments received on 03/15/2005 (pgs. 9-10).

Mr. Ryan stated the need to get confirmation/approval from the applicants, however, after several weeks, there has been no confirmation/approval. Thus, the claims are currently being objected to for being non-descriptive in what is to "automatically configure a device for communicating on a communication network", which is equivalently stated in the independent claims.

Claim Objections

2. Claims 1-4,6-11 and 13-20 objected to because of the following informalities: claims 1,8 and 15 are not descriptive in what is meant by "automatically" configuring a device to communicate on a communication network. Examiner suggests language that shows automatic configuration not requiring *any* user input as stated in the allowable subject matter and applicant's arguments. Appropriate correction is required.

Allowable Subject Matter

3. Claim 1-4, 6-11 and 13-20 are allowed.

4. The following is the statement of reasons for the indication of allowable subject matter:

The prior art disclosed by the applicant and cited by the Examiner fail to teach or suggest, alone or in combination, the systems and method as disclosed in claims 1, 8 and 15, including all the stated limitations, in particular where the automated/automatic registration and activation occurs at boot up and part of the automated/automatic registration and activation is the forwarding of a network unit device identifier, e.g., an address. Note that the applicant admits that the instant application does not require ANY user/manual input and the network configuration of the wireless device is done automatically (e.g., page 10 of arguments), where the wireless device already has a network unit device identifier prior to bootup which is forwarded to the server during bootup. The closest prior art reference found, Fingerhut, though very similar, has a prompt for the user to enter what is the applicant terms network unit device identifier (Fig. 2, step 3 and Column 3, lines 45-55). Again, applicant has admitted that the instant application does not encompass this, where network configuration is fully automated.

Conclusion

5. This application is in condition for allowance except for the following formal matters:

Claims objections to claims 1, 8 and 15.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.


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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan S. Chen whose telephone number is 571-272-4143. The examiner can normally be reached on M-F 8:30am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim N. Huynh can be reached on (571) 272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASC
01/03/2005



KIM HUYNH
SUPERVISORY PATENT EXAMINER
01/04/06